



DFW

Attorney Docket No.: SONY-50P3845

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Date of Deposit:	7/1/05	Name of Person Making the Deposit:	Jose S. Garcia	Signature of the Person Making the Deposit:
				<i>Jose S. Garcia</i>

In re Application of: Luna et al.

Application Serial No. : 09/707,521

Group Art Unit: 2613

Filed : November 06, 2000

Examiner: REKSTAD, E.

For : IMPLEMENTATION OF A DV VIDEO DECODER WITH A VLIW PROCESSOR AND A VARIABLE LENGTH DECODING UNIT

Mail Stop Petition
Commissioner for Patents
P.O Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW PREMATURENESS OF FINAL REJECTION, TO ENTER APPLICANTS' RESPONSE, AND TO WITHDRAW HOLDING OF ABANDONMENT
(37 CFR 1.181, MPEP 706.07(c), MPEP 711.03(c)(I))

1. Applicants petition that the final rejection be withdrawn for being premature, the Applicants' response mailed 2/10/2005 be entered, and the holding of abandonment be withdrawn due to Applicants' response mailed 2/10/2005, which was timely filed and fully responsive.

2. **FACTS AND ARGUMENTS IN SUPPORT OF PETITION**

FACTS

On page 8 of the Final Office Action mailed 6/15/2004, it was stated that, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**"

Applicants submitted a response mailed 8/13/04 that did not amend any of the claims and traversed all of the rejections.

In an Interview Summary (9/14/2004), the Examiner stated that, "The final rejection mailed 6/15/2004 has been withdrawn."

However, on page 2 of the Final Office Action mailed 11/2/2004, it was stated that, "Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 'Low-Power Video Encoder/Decoder Chip Set For Digital VCR's by Hasegawa et al." In the Final Office Action mailed 11/2/2004, Hasegawa et al. and US Patent 5,845,083 to Hamadani et al. are newly cited art to support the new ground(s) of rejection. Moreover, on page 8 of the Final Office Action mailed 11/2/2004, it was stated that, **"THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a)."

Applicants submitted a response mailed 2/10/05 that did not amend any of the claims and traversed all of the rejections. Further, Applicants argued that the Final Rejection was premature. It was stated that under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP 706.07(a). Here, the new ground of rejection was neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Thus, the final rejection of Claims 1-37 made in the Office Action (mailed 11/2/2004) was premature. Withdrawal of the premature final rejection was respectfully requested. Furthermore, it was stated that a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement, of any claim not amended by applicant. See MPEP 706.07(a). Hasegawa et al. and US Patent 5,845,083 to Hamadani et al. were newly cited art used to reject claims not amended by Applicants. Hence, the final rejection of Claims 1-37 made in the Final Office Action (mailed 11/2/2004) was premature. Again, withdrawal of the premature final rejection was respectfully requested.

In an Advisory Action mailed 5/6/2005, it was stated that Applicants' response mailed 2/10/05 was not entered because it failed to place the application in condition for allowance. Further, it stated that, "Though, the action contains new grounds of rejection. The new grounds of rejection are necessitated by the applicants amendments to the claims in the response filed on April 5, 2004." Moreover, it was stated that the reply period expired 6 months from the mailing date (11/2/2004) of the final rejection.

Since the reply period had expired 6 months from the mailing date (11/2/2004) of the final rejection, this application was held abandoned.

ARGUMENTS

Applicants contend that the application is not in fact abandoned since the Final Office Action mailed 11/2/2004 was premature and should have been withdrawn and since the Applicants' response mailed 2/10/05 should have been ordinarily entered based on withdrawal of the premature final rejection mailed 11/2/2004.

As mentioned above, the Final Office Action mailed 11/2/2004 introduced new grounds of rejection based on newly cited art (Hasegawa et al. and US Patent 5,845,083 to Hamadani et al.) and disregarded MPEP 706.07(a). In the Final Office Action mailed 11/2/2004, the Examiner never stated that the new grounds of rejection were necessitated by the applicants' amendments to the claims in the applicants' response filed on April 5, 2004. The Applicants were untimely informed in an Advisory Action mailed 5/6/2005 that, "Though, the action contains new grounds of rejection. The new grounds of rejection are necessitated by the applicants amendments to the claims in the response filed on April 5, 2004."

Applicants respectfully submit that the Final Office Action mailed 11/2/2004 was premature for reasons stated above and was incomplete and unclear in violation of 37 CFR 1.104. As a result, the Final Rejection presented by the Final Office Action mailed 11/2/2004 should be withdrawn and the Applicants' response mailed 2/10/05 should be ordinarily entered based on withdrawal of the premature final rejection mailed 11/2/2004. In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all the actions taken by the examiner during prosecution of an application. See MPEP 707.07(f). In the present application, the Examiner failed to provide a clear explanation for the actions taken in the Final Office Action mailed 11/2/2004. The Examiner did not provide the reason for the new grounds of rejection introduced in the Final Office Action mailed 11/2/2004 and waited to the detriment of the Applicants until the Advisory Action mailed 5/6/2005 to provide the reason for the new grounds of rejection introduced in the Final Office Action mailed 11/2/2004, in disregard of MPEP 707.07(f).

Therefore, Applicants petition that the final rejection in the Final Office Action mailed 11/2/2004 be withdrawn for being premature, that the Applicants' response mailed 2/10/2005 be entered, and that the holding of abandonment be withdrawn due to Applicants' response mailed 2/10/2005, which was timely filed and fully responsive.

3. Petition Fee Payment

Since Applicants contend that the application is not in fact abandoned, no petition fee is required. See MPEP 711.03(c)(I). However, if a petition fee is required, the petition fee required is paid as follows:

☒ The Commissioner is hereby authorized to charge any fees associated with this communication or credit any overpayment to Deposit Account No.: 23-0085.

A duplicate copy of this authorization is enclosed.

☐ A check in the amount of _____

☐ Charge any fees required or credit any overpayments associated with this filing to Deposit Account No.: 23-0085.

Please direct all correspondence concerning the above-identified application to the following address:

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Respectfully submitted,

Date: 7/1/2005

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